

REMARKS

1) The Examiner has provisionally rejected claims 1-2 and 11 under the non-statutory, judicially created doctrine of obviousness-type double patenting over claims 1-19 of copending U.S. Pat. App. 10/575,332. The Examiner has further provisionally rejected claims 1-2 and 11 under the non-statutory, judicially created doctrine of obviousness-type double patenting over claims 1-19 of copending U.S. Pat. App. 10/577,870.

It should be first noted that the remaining claims in this application are 1, 2, 10, and 11. Applicants believe that the Examiner has inadvertently overlooked claim 10 in his rejections of claims 1, 2, and 11. Thus, it is urged that claim 10 is still pending in this case, and Applicant's arguments herein relate to all of claims 1, 2, 10, and 11.

The Examiner states that no terminal disclaimers were received by the USPTO with Applicant's previous submission. The Examiner asks for such terminal disclaimers to be submitted at this time. It should first be noted that the first citation, copending Application No. 10/575,332 has been abandoned. Thus, the double patenting rejection based on this application is now moot. Regarding the second citation, Applicants submit herewith a terminal disclaimer relating to copending Application No. 10/577,870. In view of this terminal disclaimer, it is respectfully urged that this ground of rejection has been overcome.

It should be noted that no further payment is required at this time, since Applicants paid for two terminal disclaimers on February 10, 2009 as they related to copending Application Nos. 10/575,332 and 10/577,870. Proof of prior payment is provided herewith, in the "Transaction list for user: Richard Roberts" and "Transaction Details" page from the USPTO, both showing that \$770 in fees was paid on 2/10/09 for Attorney Docket No. TAN-121. The "Transaction Details" page shows two payments each for

\$140.00, for two statutory disclaimers on 2/10/09. The Commissioner is authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required by this paper, or credit any overpayment, to Deposit Account No.18-1589 if necessary.

2) The Examiner has rejected claims 2 and 11 under 35 U.S.C. 103 over JP 2002-129259 (hereinafter JP '259). However, Applicants respectfully submit that JP '259 fails to teach or suggest an alloy having the required components of the presently amended claims.

As presently amended, claims 2 and 11 both include a silver alloy for use in a reflective film, *consisting essentially of*: silver; palladium as a first dopant element; and any of indium, terbium, gadolinium, neodymium, holmium, yttrium, praseodymium, samarium, ytterbium, lanthanum, or cerium as a second dopant element, wherein a total of the concentration of the first dopant element and the concentration of the second dopant element are 0.01 to 2.0 atomic %. Magnesium has been removed from the list of second dopant elements according to the present amendment. The inventive alloys must therefore contain silver, palladium, and any of the above listed second dopant materials. Such a combination is not taught by JP '259.

First, it is urged that while JP '259 discloses a silver alloy which contains silver and optionally palladium, *nowhere* does the reference teach or suggest an alloy of silver, palladium, and a second dopant element selected from the materials required by the present claims. That is, it is clear that nowhere does JP '259 mention indium, terbium, gadolinium, neodymium, holmium, yttrium, praseodymium, samarium, ytterbium, lanthanum, or cerium at all. It is submitted that one skilled in the art would not have been inspired to formulate a silver alloy having the particular combination of components as presently claimed, upon a reading of JP '259.

Furthermore, it is urged that the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that *do not* materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549,

551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). Thus, the present claim 2 clearly defines the inventive silver alloys as those which contain silver, palladium as a first dopant element, and a second dopant element of the required materials, while *excluding* all others which would materially affect the basic and novel characteristics of the claimed alloys. The JP '259 reference *requires* the presence of gold in their alloy, as it states that "Ag is used as the main component, 0.1 to 3.0 wt.% Au is added to the Ag", and further at least one or more elements listed in their abstract are added to the Ag. In contrast, the "consisting essentially of" language of the present claim 2 effectively *excludes* gold, which would clearly materially affect the basic and novel characteristics of the claimed alloy. In addition, as stated in the specification, in certain instances it is undesirable to use gold, which is more expensive than silver. Thus, the presently claimed alloys of claim 2 are particularly formulated to be absent of gold. It is submitted that JP '259 *does not* teach or suggest a silver alloy which does not contain gold, and thus fails to obviate the presently claimed silver alloys of claims 2 and 11.

It is submitted that JP '259 provides no motivation for one of ordinary skill in the art to formulate silver alloys of the present claims. That is, an artisan having common sense at the time of the invention would not have reasonably considered modifying the silver alloys of JP '259 to exclude gold, and instead contain the second dopant materials required by the present claims, which are not disclosed anywhere in the cited art. For the above reasons it is therefore respectfully requested that the 35 U.S.C. 103 rejection of claims 2 and 11 has been overcome and should be withdrawn.

3) The Examiner next rejects claims 1 and 2 under 35 U.S.C. 103 over U.S. Patent No. 4,494,833 to Takamura. The Examiner takes the position that one skilled in the art would have obviously optimized the alloy materials of Takamura to formulate the presently claimed silver alloys. Applicants respectfully urge that this is not the case.

First, claims 1 and 2 of the present invention each relate to silver alloy *for use in a reflective film* such as in optical recording media, displays and the like. As stated

throughout the specification, the inventive alloys are specifically formulated to exhibit superior reflectivity properties. In contrast, the alloys disclosed by Takamura reference have *nothing* whatsoever with reflective properties or reflective films at all. That is, the alloys of Takamura are used as a covering (see feature 7 of Fig.2) for coating the metal arms of eyeglass frames. Thus, not only is Takamura in a non-analogous art to the present invention, but the motives of Takamura are clearly different from the present invention. It is urged that whether or not some of the components of the presently claimed alloys may coincidentally be present in the coating materials of Takamura, one skilled in the art clearly would not have been inspired to optimize the alloys of Takamura for enhancing their reflectivity properties, since their only use is for coating metal arms of eyeglass frames.

Nevertheless, for purposes of clarity, the present claims have been amended to no longer include zinc or magnesium in their alloy materials. Thus, it is urged that this ground of rejection has been overcome for the reasons stated below.

Claim 1, as amended herein, relates to a silver alloy for use in a reflective film, consisting essentially of: silver; gold as a first dopant element; and any of, indium, terbium, gadolinium, neodymium, holmium, yttrium, praseodymium, samarium, ytterbium, lanthanum, or cerium as a second dopant element, at particular concentrations. As stated above, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that *do not* materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). Thus, the present claim 1 clearly requires that the claimed alloys contain silver, gold as a first dopant element, and a second dopant element of the required materials, while *excluding* all other components which would materially affect the basic and novel characteristics of the claimed alloys. The Takamura reference *requires* the presence of copper, zinc, and nickel in both their silver base alloys and gold base alloys. However, these materials are effectively excluded from the presently claimed alloy by the "consisting essentially of" language of claim 1. Takamura

*does not* provide any alloys which do not contain copper, zinc, and nickel, and thus this reference fails to obviate the alloys of the presently amended claim 1.

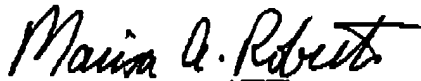
Regarding claim 2 as amended herein, this claim relates to a silver alloy for use in a reflective film, consisting essentially of: silver; palladium as a first dopant element; and any of indium, terbium, gadolinium, neodymium, holmium, yttrium, praseodymium, samarium, ytterbium, lanthanum, or cerium as a second dopant element, at particular concentrations. As stated above, the "consisting essentially of" language of the present claim 2 effectively *excludes* gold from the present silver alloy. However, both Takamura's gold base alloy and silver base alloy require the presence of gold. In addition, the present claim language excludes copper, zinc, and nickel which are all required in the alloys of Takamura. Since the cited reference fails to teach or suggest any alloy which does not contain gold, copper, zinc, or nickel, it is submitted that this reference fails to teach or suggest any of the presently claimed alloys according to claim 2, as amended.

It is submitted that one skilled in the art would not have been inspired to formulate the particular silver alloy formulations required by the presently amended claims 1 and 2, based on the teachings of Takamura. Thus, for all of the above reasons, Applicants respectfully submit that the 35 U.S.C. 103 rejection has been overcome and should be withdrawn.

The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the Examiner believes there is any matter which prevents allowance of the present application, it is requested that the

undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



Marisa A. Roberts

Reg. No. 43,048

P.O. Box 484

Princeton, New Jersey 08542

(609) 921-3500

Date: August 12, 2009

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (FAX No. 571-273-8300) on August 12, 2009.



Marisa A. Roberts

Reg. No. 43,048